

Remarks

The claims have been amended to expressly clarify the patentability of the invention. Claims 1 has been amended to make clear that the mouthpiece and the holder each consist of a single piece of molded plastic, that the holder is inserted directly into the mouthpiece, and that the resilient rings are a separate claim element and are not part of the holder. Claims 1-6 and 8-12 and 14-18 were rejected over Grasso (US 3,313,308) in view of Walters and Mensik. The Office Action states that Grasso fails to teach a holder that consists of a single piece of molded plastic. The OA relies on Walters to prove that it is known to construct the holder out of a single piece of material and refers to Figure 2. Figure 2 of Walters is a sectional view of the holder. Figure 3 is an exploded view of the holder. It is respectfully noted that Figures 2 and 3 show that Walters' holder has four distinct parts and not just one, the mouthpiece sleeve 14, the tubular steel valve 16, a cigarette sleeve 18, and the shank 20. The specification also describes disassembling the holder for cleaning by exerting a lengthwise pull whereupon the rubber o-rings will release the mouthpiece sleeve 14 and sleeve valve 16 from the filter shank 20, exposing the filter shank for cleaning (col.2, lines 13-21).

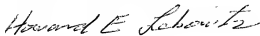
Therefore the prior art does not disclose or suggest a holder consisting a single piece of molded plastic. Respectfully, Walters does not disclose either a single piece of material or molding as a method of construction (Walters talks about the cigarette sleeve of shank as being bored out to provide recess 26 – column 1 lines 54-56).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art."

With further regard to claim 7, which adds Daily, for teaching a cigarette mouthpiece comprising polystyrene, and Taylor for teaching that ABS is an injection molded plastic. It is respectfully argued that Taylor is non-analogous art, since Taylor is an application dealing with a CD rack. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Of course Claim 7 is also patentable because it depends from Claim1.

Applicant believes that claims 1-12 and 14-18 are now in condition for allowance and therefore requests reconsideration and allowance of these claims. If examiner desires to discuss any matter involving this case please contact the undersigned attorney at 510-785-8070 between 9 am and 5 pm PST.

Respectfully Submitted,



Foothill Law Group LLP
Howard E. Lebowitz
Attorney for the Applicant
Reg. No. 44864
19682 Hesperian Blvd., Suite 208
Hayward, CA 94541
510-785-8070